

Serial No. 10/657,722
Attorney Docket No. 2185.010USU (AUC-32822)

Amendment and Response After Final Rejection

REMARKS

This response replies to the Final rejection of Claims 1-5, 7-11, 13-15, and 17-20 as stated in the Office Action mailed March 3, 2005 (the "Final Action"). Applicants have amended claims 1, 10, 12, and 20 to place the application in condition for allowance and to reduce the issues for appeal. Given these amendments, which contain no new matter, and in light of the remarks below, the claim rejections under 35 U.S.C. §§ 102 and 103 now are moot, and Applicants respectfully request their withdrawal, the withdrawal of the objections to claims 6 and 16, and that the application be allowed.

Claim Rejections Under 35 U.S.C. § 102

Applicants respectfully traverse the rejections of claims 1-5, 7-11, 13-15, and 17-20 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 2,537,058 to Jamison ("Jamison"). Applicants have amended claims 1, 10 and 20 to clarify that the compressible cover is adapted to sheath the anchor point of the compass when the anchor point is not engaged with a surface. These amendments render the § 102 rejections moot, because Jamison lacks a compressible cover adapted to sheath an anchor point of the compass when the anchor point is not engaged with a surface. Instead, as explained more thoroughly below, Jamison discloses a suction cup.

The plain language in Jamison and the pending application demonstrate that the suction cup in Jamison is not the cover claimed in the pending application. Jamison refers to "a flexible rubber-like cup," assigned reference numeral 16 (col. 3, lines 71-72), or a "cup-like member," assigned reference numeral 25 (col. 4 lines 31-34). The Applicants, on the other hand, claim a compressible cover adapted to encase an anchor point when the compass is not in use against a surface. A standard English dictionary dispels the notion that Jamison's "cup-like member" or "rubber-like cup" is such a cover.

A "cover," when that term is used as a noun (as in the pending application), is defined as "n. 1. [s]omething that covers" *The American Heritage Dictionary of the English Language* (4th ed. 2000), p. 421 (see also <http://www.bartleby.com/61/32/C0703200.html>). This definition requires knowledge of the verb, to cover: "v. 1. [t]o place something upon or over, so as to protect or conceal." *Id.* (emphasis added). Thus, the plain English definition of the word

MAD/108269.1

Serial No. 10/657,722

Amendment and Response After Final Rejection

Attorney Docket No. 2185.010USU (AUC-32822)

"cover" involves protecting or concealing something. Applicants' cover is specifically designed to protect the user of the compass and conceal the anchor point. The amended claims expressly state that the cover is adapted to sheath the anchor point when the anchor point is not engaged with a surface. The narrow shape of Applicants' cover, shown in Figures 5-8, further demonstrates that its close proximity to the compass's anchor point encases it, impeding accidental contact with the sharp point.

The cup-like member in Jamison, on the other hand, is not used for protecting or concealing anything, contrary to the definition of "cover." The sole purpose of Jamison's cup is to allow the compass "to engage [a] plane surface for establishing a relatively air-tight seal therewith" Jamison, col. 5, lines 10-11. When it is not engaged with a surface, Jamison's cup does not cover the anchor point because the cup "terminates in an enlarged peripheral edge portion." *Id.*, col. 5, lines 8-9. Jamison's cup is widest at its base, extending away from the compass's anchor point. This bulbous shape, depicted in Jamison's Figures 1, 6, and 9, is not conducive to protecting or concealing (i.e., covering) the anchor point of a compass, because it allows for considerable unencumbered access to the exposed point. In fact, the cup-like shape required of Jamison's suction cup necessitates that it *exposes* the anchor point as it extends peripherally from its point of attachment to the compass member. Thus, Jamison does not disclose a cover that is adapted to sheath the anchor point when the anchor point is not engaged with a surface, as the Applicants have claimed.

Jamison does not teach a compass "wherein said compressible cover is tubular" and a compass "wherein said compressible cover is a hollow tube." See Final Rejection, pp. 2, 3. Jamison's cup-like member has only a "cylindrical *portion*," meaning the part of the cup-like member that attaches to the compass. Jamison, col. 4, lines 31-33, Figs. 4-6 (see reference numeral 24). Jamison's cup-like member is *cup shaped*, not cylindrical, with a peripheral edge considerably wider than its internal diameter. Applicants' claimed cover, on the other hand, is tubular ("Compressible point cover 115 is preferably a generally cylindrical, unitary member.") See Specification, p. 9; see also, e.g., Figs. 1-3, 7, 9. Thus, Jamison does not disclose a cover adapted to sheath the anchor point, and lacking this element, does not anticipate the rejected

Serial No. 10/657,722

Amendment and Response After Final Rejection

Attorney Docket No. 2185.010USU (AUC-32822)

claims. Applicants respectfully request that the rejections under § 102 be withdrawn, and submit that claims 1-5, 7-11, 13-15, and 17-20 should be allowed.

Claim Rejections Under 35 U.S.C. § 103

On obviousness grounds, the Examiner rejected claim 12, which depends from claim 10, as unpatentable over Jamison in view of U.S. Patent No. 2,045,298 to Hanle ("Hanle"). This rejection is moot in light of the claim amendments, for at least two reasons. First, as discussed above, Jamison does not teach an essential element of the amended independent claim 10, namely a cover adapted to sheath an anchor point of the compass when the anchor point is not engaged with a surface, and Hanle does not disclose this missing element. Jamison and Hanle fail to disclose an essential element, and they offer no suggestion to modify their devices to include the cover required by claim 12. Therefore, Jamison and Hanle together cannot make the invention of claim 12 obvious and unpatentable under § 103.

Second, Hanle does not disclose a compass assembly wherein the *pivotal* connection between the first and second members comprises a gear mechanism, as required in amended claim 12. Instead, Hanle's first and second members are pivotally connected by a rivet (19). See Hanle, Fig. 1, col. 2, lines 49-55. Although Hanle contains three elements that create a gear mechanism (the Examiner identified the "opening," "nut," and "gear teeth" (23, 24, 25)), this gear mechanism does not create a pivotal connection between the first and second members of Hanle's compass. See *id.*, Figs. 1-2, col. 2, lines 49-55. Rather, these elements "cause the compass leg 11 to be shifted along the rack 20." *Id.*, Fig. 4, col. 3, lines 27-28. Because Hanle teaches only a *rivet* that pivotally connects the two members of a compass, it would not be obvious to one of ordinary skill in the art to modify the device of Jamison to include a gear mechanism to pivotally connect the two members. Accordingly, Applicants respectfully request that the Examiner accept the amendment to claim 12 and withdraw the rejection under § 103.

Applicants traverse the Final Rejection under §§ 102 and 103, and have amended claims 1, 10, 12 and 20 to place the application in condition for allowance. Applicants request that the amendments, which add no new subject matter, be entered. Applicants believe that all of

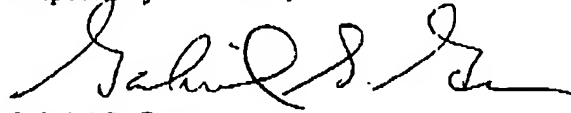
Serial No. 10/657,722

Attorney Docket No. 2185.010USU (AUC-32822)

Amendment and Response After Final Rejection

the claims are patentable for the reasons stated above, and therefore request that the Examiner withdraw the rejections and issue a Notice of Allowance for Claims 1-20.

Respectfully submitted,



Gabriel S. Gross

Registration No. 52,973

Dated: April 28, 2005

Whyte Hirschboeck Dudek S.C.
555 East Wells Street, Suite 1900
Milwaukee, WI 53202-3819
Phone: (414) 273-2100
Customer No.: 22202